

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Susan Slaughaupt et al.

Group Art Unit: 1634

Serial No.: 10/041,856

Examiner: Carla Myers

Filed: January 7, 2002

Confirmation No.: 5418

For: Gene for identifying individuals with familial dysautonomia

REQUEST FOR CORRECTION OF PATENT TERM ADJUSTMENT

UNDER 37 C.F.R. § 1.705(b)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This letter is to request correction of the Patent Term Adjustment under Rule 705. Specifically, the Patent Term Adjustment calculation included with the USPTO communication of November 14, 2007 omits the period of adjustment under Rule 703(b). The \$200 fee required by Rule 18(e) is authorized herewith. This application is not subject to a terminal disclaimer.

Pursuant to Rule 703(b), the Office was to grant a term adjustment for the number of days that exceeds 36 months from the filing date of the application to the issue date of the application, excluding

- 1) the period following the filing of an RCE,
- 2) (i) following the declaration of an interference,
(ii) the period of suspension of prosecution due to an interference,
- 3) the period the application is under seal, and
- 4) the period of appeal.

Where a notice of appeal is filed, the period of adjustment under this paragraph "restarts" upon the mailing of a non-final office action (See Rule 703(b)(4)). The calculation of periods for Patent Term Adjustment follows.

Calculation of Periods for Patent Term Adjustment

Under Rule 703(b)

The application was filed on January 7, 2002, and the period exceeding 36 months begins January 7, 2005. An RCE was filed on June 2, 2006. The period between January 7, 2005 and June 2, 2006 is 511 days.

Thus, the total period of USPTO delay under Rule 703(b) is 511 days.

Under Rule 703(a)

Applicants agree with the USPTO determination that the PTO incurred 468 days delay under 703(a) for the period beginning 14 months from filing (i.e. March 2, 2003) until the mailing of a Restriction Requirement on June 17, 2004.

Reduction Under Rule 704

Applicants do not dispute the USPTO determination of 478 days of Applicant delay.

Period of Patent Term Adjustment

The period for patent term adjustment should be the sum of non-overlapping days under Rules 703(a) and 703(b) minus the days of Applicant delay.

In Form PTOL-85, mailed November 14, 2007, the USPTO calculated that the Applicants are entitled to 0 days of patent term adjustment. In the "Patent Term Adjustment" tab in the official image file wrapper (Private-PAIR) for this application, the USPTO does not include a value for the USPTO's delay under Rule 703(b). The USPTO has previously indicated that its policy is to view Rule 703(a) delays occurring before three years from filing as overlapping with Rule 703(b) delays occurring after three years from filing. See Federal Register, vol. 69, no. 118, page 34384, footnote 5, June 21, 2004. The USPTO has failed to follow its own policy in finding 0 days of patent term adjustment. Using its own interpretation, the USPTO should have arrived at a patent term adjustment of 33 days. In other words, the USPTO should have found 511 days of delay under Rule 703(b) (which by USPTO interpretation overlaps with and, thus, also encompasses, the 468 days of delay under Rule 703(a)) and 478 days of Applicant delay. The calculation of 511-478 yields 33 days of patent term adjustment using the USPTO's interpretation of the statute.

However, the plain reading of the statute does not permit the USPTO to excuse one delay simply because they caused another delay. Applicants believe that in this case the delays under Rules 703(a) and 703(b) are non-overlapping. In other words, the USPTO delay from March 7, 2003 until June 17, 2004 (delay under Rule 703(a)) does not overlap with the USPTO delay from January 7, 2005 to June 2, 2006 (delay under Rule 703(b)), respectively. Therefore, Applicants are entitled to the sum of all the delays minus the days of Applicant delay, yielding a calculation of $(511 + 468) - 478 = 501$ days.

Summary of Requested Correction to PTA

The patent term adjustment of 0 days according to USPTO Form PTOL-85, mailed November 14, 2007 is incorrect because it does not include delays under Rule 703(b).

Applicants request that the patent term adjustment be corrected to add 501 days of term as follows:

- 1) changed from 0 days to 33 days according to the USPTO's stated policy, and
- 2) changed from 33 days to the correct value of 501 days, according to the plain language of the statute rather than USPTO's misinterpretation of the statute.


AUTHORIZATION

The Commissioner is hereby authorized to charge the fee set forth in 37 C.F.R. § 1.18(e) to Deposit Account No. **50-3732**, Order No. 13572-105039. The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this communication to Deposit Account No. **50-3732**, Order No. 13572-105039. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **50-3732**, Order No. 13572-105039.

Respectfully submitted,
King & Spalding, LLP

Dated: November 30, 2007

By:


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